

REMARKS

Claim 7 is amended, no claims are canceled or added; as a result, claims 1-9 and 11-17 are now pending in this application.

35 U.S.C. § 112 Rejection

In view of the Examiner's objection to claim 7 under 35 U.S.C. 112, the Applicants respectfully traverse and assert that claim 7 meets the requirements of Section 112. Nonetheless, applicants herein amend claim 7 to move prosecution forward. This amendment to claim 7 does not narrow the scope of the claim and is not made in reply to this rejection.

Double Patenting

In the Office Action, the Examiner has provisionally rejected claims 1-9 and 11-17 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 09/836,014 (hereinafter the "Copending application").

The Applicants respectfully disagree. Claim 1 of the present application provides for a structural wooden joist comprising, in addition to an elongated lower chord and an elongated upper chord, a "*laminated panel structure defining an uninterrupted surface from one end of the joist to an opposite end thereof*", while claim 1 of the copending application provides for a structural wooden joist comprising, in addition to an elongated lower chord and an elongated upper chord, an "*openwork web structure joining said chords; said web structure comprising a series of connector members formed of inclined branches and adhesively secured to said lower and upper chords; each said branch of said connector members being formed of at least two planks having contiguous sides adhesively joined to one another; said connector members defining a series of triangular openings in said web structure*".

If the present application provides for an uninterrupted surface and the copending application provides for an openwork web structure and a series of triangular openings, it cannot be said that claim 1 of the present application "*is generic to all that is recited in claim 1*" of the

compending application. As the Examiner has failed to justify a prima facie case of obviousness when comparing the compending claims, the Applicants therefore respectfully submit that the provisional rejection based on nonstatutory obviousness-type double patenting is without foundation.

Anticipation

In the Office Action, the Examiner has rejected claim 1, 3, 5, 7, and 8 under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 4,191,000 to Henderson (hereinafter "*the Henderson reference*").

The Applicants respectfully disagree. As set forth by 35 U.S.C. § 102(b) and applicable case law, a reference must teach every element of a claim to anticipate the claim. The Applicants refer the Examiner to *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987), in which it is stated, "*A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.*"

In addition to this citation, it is stated in *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F. 2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991), "*There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.*"

Accordingly, the Applicants indicate that claim 1 of the present application provides for a structural wooden joist comprising, in addition to an elongated lower chord and an elongated upper chord, a laminated panel structure joining said chords "*being formed of a series of elongated planks adhesively secured edgewise to one another and extending vertically between said lower and upper chords*" (emphasis added). "Elongated" can be defined as "stretched out" or "slender", which means that the planks of the present application have an edge that is parallel to the chords that is shorter than the edge perpendicular to the chords. The fact that the planks "*extend vertically between said lower and upper chords*" reinforces the shape of the planks.

The Henderson reference does not provide for such a laminated panel structure. Rather, the Henderson reference provides for a web member 22, joining a lower chord 20 and an upper chord 20, composed of a plurality of segments, each having a length corresponding to the width of the sheet of plywood from which it was cut. The Henderson reference indicates that such length is commonly 48 inches. Reference is made to column 3, lines 5 of the Henderson reference.

The Henderson reference therefore teaches that the individual segments of the web member have length parallel to the upper and lower chords that is longer than the height of the individual segments between the upper and lower chords, and this is clearly illustrated in Figs. 1 and 4 of Henderson. This, in effect, teaches away from the presently claimed structure, which provides for laminated panel structure formed from a series of elongated planks, which have a height that is longer than their width. This provides the improvement provided in claim 1, “wherein said joist is adapted to be cut at any length thereof”.

The Applicants therefore respectfully submit that claim 1 is not anticipated by the Henderson reference. In addition, given that the Henderson reference teaches away and does not even suggest the claimed features of the laminated panel structure of the present application as set forth in the excerpt cited above, the Applicants respectfully submit that the invention of the present application would not have been obvious to one skilled in the art in light of the Henderson reference.

With respect to claim 3, which provides that *“said panel is secured to said chords by finger joints”*, the Applicants respectfully submit that finger joints are not anticipated by the use of a “V-shaped” joint provided in the Henderson reference. Finger joints allow for a greater contact surface area to be used to secure the panel to the chords than a “V-shaped” joint. The Henderson reference actually teaches away from finger joints as it stresses the use of a two-rib design. Reference is made to column 5, lines 4-7 of the Henderson reference. The Applicants therefore respectfully submit that claim 3 is not anticipated by the Henderson reference.

With respect to claim 8, which provides that *“said planks are joined to one another by a V-shaped joint”*, the Applicants respectfully submit that the joint that is being referred to in claim

8 is not the joint between the web member and the chord. The Examiner makes reference to Fig. 3 of the Henderson reference, which provides a close-up view of the two-rib joint between the web member and a chord of the Henderson reference. Claim 8, however, refers to the joint between two planks of the laminated plank structure of the present application. The Applicants therefore respectfully submit that claim 8 is not anticipated by the Henderson reference.

As for the Examiner's rejection of claim 9 under 35 USC § 103(a), the Applicants note that Henderson has limitations pertaining to the use of "*elongated planks*" secured to one another. As argued above, this is a novel feature that is not taught by Henderson, whereby the rejection under 35 USC § 103(a) is deemed to be unjustified.

In view of the above remarks, the application is deemed to be in condition for allowance, and early notice to that effect is earnestly solicited.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

18 July '07

By


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CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18th day of July 2007.

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